



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,957	12/07/2001	Carol J. Nikolaus	076565-0119	5680

26371 7590 01/27/2004
FOLEY & LARDNER
777 EAST WISCONSIN AVENUE
SUITE 3800
MILWAUKEE, WI 53202-5308

EXAMINER

SMALLEY, JAMES N

ART UNIT PAPER NUMBER

3727

DATE MAILED: 01/27/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/010,957

Applicant(s)

NIKOLAUS ET AL.

Examiner

James N Smalley

Art Unit

3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31, 37-65 and 75-88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31, 37-65 and 75-88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 3727

DETAILED ACTION

Response to Amendment

1. Due to the new grounds of rejection, this action is **Non-Final**.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 51, 55-57 and 87 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The addition of element (13) and figures 8a and 8b comprise new matter, for containing subject matter not described in the specification at the filing date. Examiner notes the original disclosure merely disclosed a "three-tiered configuration for wet-dry applications." This functional language clearly does not sufficiently describe the structure platform (13) as described in figs. 8a and 8b.

Further, figure 8a contains two cylindrical elements, at the top of cover (12), which were not previously presented in the figures.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5, 42-44, 48-50, 52, 75-79, 83-85 and 88 rejected under 35 U.S.C. 102(b) as being anticipated by Okojima et al. US 4,799,604.

Art Unit: 3727

Okojima '604 discloses a vanity case, comprising a hinge assembly (14) coupling a cover (12) to a base (10), where the base and cover are provided as separate pieces, and having a tray (16) for containing a cosmetic material (see col. 3, lines 34-35, wherein it is disclosed the tray holds a cosmetic) and having a spring (62), serving to conceal the cosmetic in a closed position, and reveal the cosmetic in an open position when the latch means is unlocked.

In col. 4, lines 21-26, it is disclosed one end of the coil spring abuts a hinge block of the cover, and the other end abuts an inner wall of the receptacle, and the spring urges the cover to the open position shown in fig. 1.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8 and 82 rejected under 35 U.S.C. 103(a) as being unpatentable over Okojima et al. US 4,799,604 as applied above under 35 USC 102(b) to claims 7 and 81.

Okojima '604 discloses the claimed invention except for the rate at which the cover opens. It would have been obvious to one having ordinary skill in the art at the time the invention was made to configure the rate the cover pivots upon opening the container to a desired rate, including less than 120 degrees per second, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

8. Claims 19-22, 37-41, 45-47, 53-54, 58-65 and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okojima et al. US 4,799,604 in view of Leung US 6,178,085.

Okojima '604 does not disclose a damping means limiting the pivot rate of the cover about the hinge.

Art Unit: 3727

Leung '085 discloses a lid mechanism comprising a hinge, a coil spring (62) encapsulated in a cartridge (38), a plug (70), and a viscous damping grease (84). Frictional engagement between the plug and the cover allows the lid to be opened in a controlled, damped manner.

It is further disclosed, in col. 5, lines 49-53, that the damping mechanism serves to, "slow down and counteract any tendency for rapid pivoting movement of the lid structure which would cause the calculator to bounce and possibly damage the delicate internal components or electronics thereof." Although explicitly disclosed for preventing damage to electronics, one having ordinary skill would immediately recognize that the mechanism could be applied to any container wherein a rapid opening movement would be detrimental. In the immediate case, one having ordinary skill in the cosmetic compact arts would recognize a slow controlled movement would prevent a makeup brush, or delicate cosmetic, from being damaged or displaced by a rapid opening movement.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the hinge structure of the vanity case of Okojima '604, providing the lid block (64) with a tubular portion/cartridge (38), coil spring (62), plug (70), and viscous damping grease (84) taught by Leung '085, motivated by the benefit of a slow, controlled, damped opening of the lid to prevent a makeup brush, or delicate cosmetic, from being damaged or displaced by a rapid opening movement.

Regarding the claimed limitations of the pivoting rate of the cover to between 60 and 120 degrees per second, Leung '085 does not disclose the rate at which the cover will pivot.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to configure the damping mechanism to open the cover to between 60 and 120 degrees per second, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

9. Claims 23-31 rejected under 35 U.S.C. 103(a) as being unpatentable over Okojima et al. US 4,799,604 in view of Leung US 6,178,085 as applied to claim 22 above, and further in view of Taniyama US 5,213,229.

Art Unit: 3727

Okojima '604 does not disclose a detent coupled to the cover or base to limit the range the cover pivots from the closed position to the open position.

Taniyama '229 discloses a motion limiting mechanism for storage containers, comprising an arcuate slot (63') disposed on a container and a protrusion (62') disposed on a cover, for limiting the opening range of the cover. It is further disclosed, in col. 2, lines 17-20, that the arc of the arcuate slot may be enlarged or decreased, so as to vary the range of motion of the cover from within 0 to 360 degrees.

It would have been obvious to add an arcuate slot to the base component, and a limiting protrusion to the cover, as taught by Taniyama '229, motivated by the benefit of customizing the opening angle of the cover.

10. Claims 6-7 and 80-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okojima et al. US 4,799,604 as applied above under 35 USC 102(b) to claims 3 and 77, and in view of Taniyama US 5,213,229.

Okojima '604 does not disclose a detent coupled to the cover or base to limit the range the cover pivots from the closed position to the open position.

Taniyama '229 discloses a motion limiting mechanism for storage containers, comprising an arcuate slot (63') disposed on a container and a protrusion (62') disposed on a cover, for limiting the opening range of the cover. It is further disclosed, in col. 2, lines 17-20, that the arc of the arcuate slot may be enlarged or decreased, so as to vary the range of motion of the cover from within 0 to 360 degrees.

It would have been obvious to add an arcuate slot to the base component, and a limiting protrusion to the cover, as taught by Taniyama '229, motivated by the benefit of customizing the opening angle of the cover.

Art Unit: 3727

11. Claims 9-18 rejected under 35 U.S.C. 103(a) as being unpatentable over Okojima et al. US 4,799,604 in view of Taniyama US 5,213,229 as applied to claim 6 above, and further in view of Leung US 6,178,085.

Okojima '604 does not disclose a damping means limiting the pivot rate of the cover about the hinge.

Leung '085 discloses a lid mechanism comprising a hinge, a coil spring (62) encapsulated in a cartridge (38), a plug (70), and a viscous damping grease (84). Frictional engagement between the plug and the cover allows the lid to be opened in a controlled, damped manner.

It is further disclosed, in col. 5, lines 49-53, that the damping mechanism serves to, "slow down and counteract any tendency for rapid pivoting movement of the lid structure which would cause the calculator to bounce and possibly damage the delicate internal components or electronics thereof." Although explicitly disclosed for preventing damage to electronics, one having ordinary skill would immediately recognize that the mechanism could be applied to any container wherein a rapid opening movement would be detrimental. In the immediate case, one having ordinary skill in the cosmetic compact arts would recognize a slow controlled movement would prevent a makeup brush, or delicate cosmetic, from being damaged or displaced by a rapid opening movement.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the hinge structure of the vanity case of Okojima '604, providing the lid block (64) with a tubular portion/cartridge (38), coil spring (62), plug (70), and viscous damping grease (84) taught by Leung '085, motivated by the benefit of a slow, controlled, damped opening of the lid to prevent a makeup brush, or delicate cosmetic, from being damaged or displaced by a rapid opening movement.

Regarding claim 18, Taniyama '229 discloses the detent and arcuate slot can be configured to allow a cover to pivot to any value between 0 and 360 degrees.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to configure the arcuate slot of Okojima '604, as modified in view of Taniyama '229, to open the cover at least 60 degrees relative to the base, since it has been held that discovering an optimum value of

Art Unit: 3727

a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Response to Arguments

12. Applicant's arguments with respect to claims 55-57 have been considered but are moot in view of the new ground(s) of rejection.

13. Applicant's arguments, see page 20, Amendment B, filed 03 November 2003, with respect to the rejection of claims 7-8, 19-31, 37-41, 47 and 63 under 35 USC 112, 2nd have been fully considered and are persuasive. The rejection of these claims has been withdrawn.

14. Applicant's arguments with respect to claims rejected under 35 USC 102(b) and 35 USC 103(a) have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 306-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 308-5648, email CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James N Smalley whose telephone number is (703) 605-4670. The examiner can normally be reached on M-Th 8-5:30, Alternate Fri 8-4:30.

Art Unit: 3727

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee Young can be reached on (703) 308-2572. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

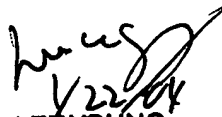
Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	http://www.uspto.gov/

jns
January 15, 2004


LEE YOUNG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700